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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,416	09/10/2003	Jeffrey D. Messerly	END0797US	4619
27777	7590	06/23/2011		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER HALL, DEANNA K	
			ART UNIT 3767	PAPER NUMBER
			NOTIFICATION DATE 06/23/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/659,416	<b>Applicant(s)</b> MESSERLY ET AL.	
	<b>Examiner</b> DEANNA K. HALL	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/7/11.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,10-14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8, 10-14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Acknowledgments*

1. This office action is in response to the reply filed 4/7/11.
2. In the reply, the applicant amended claims 1, 5, 7, 16, 20, 21; canceled claim 4. Claims 1-3, 5-8, 10-14 and 16-21 are pending in the application.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-8, 10-11 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo et al. (US 5,275,607) ("Lo") in view of Schwemberger et al. (US 6,589,200) ("Schwemberger").** Schwemberger discloses:

An ultrasonic transducer 12 having a proximal and a distal end; an ultrasonic waveguide 30, Fig. 1 having an ultrasonically actuated blade 38 positioned at the distal end of the waveguide Fig. 2.

Schwemberger discloses the invention as substantially claimed but does not directly disclose the blade being asymmetric and having an end positioned in an overlapping C9L30-36 with at least a portion of the asymmetric portion of the blade. Lo, in the analogous art, teaches a movable asymmetric blade member 30 with an end

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positioned in an overlapping C9L30-36 with at least a portion of the asymmetric portion of the blade. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have modified the device of Schwemberger with the asymmetric blade as taught by Lo as an obvious matter of design choice of articulating surgical shears.

The lumen of Lo is designed to provide suction or irrigation to a surgical site, see claim 15, C7 L33-43.

The blade of Schwemberger is designed to vibrate in a longitudinal motion coupled with either a transverse or torsional motion, see abstract and thus, the lumen of Lo when combined would be fixed or moveable to a position adjacent to the transverse or torsional node to facilitate suction C5 L40-55. The instrument proximal end has controls for suction and or irrigation C15 L39-46.

**5. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwemberger in view of Lo.**

Schwemberger/Lo discloses the invention as substantially claimed (see above). However, this combination does not directly disclose the blade defining a channel for irrigation or suction. The channel for irrigation or suction in Lo is within the lumen. Applicant has not disclosed that having the channel within the blade rather than a separate lumen solves any stated problem or is for any particular purpose. Moreover, it appears that the lumen of Lo, or applicant's channel in the blade would perform equally well. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Lo such that the irrigation or

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suction channel would be within the blade because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Lo.

### ***Response to Arguments***

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEANNA K. HALL whose telephone number is (571)272-2819. The examiner can normally be reached on M-F 11:00am-7:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DEANNA K HALL/  
Examiner, Art Unit 3767

/Theodore J Stigell/  
Primary Examiner, Art Unit 3763